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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/732,333	12/06/2000	Roger D. Pirkey	10942/269227	1489
27498	7590	10/25/2007		
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			ART UNIT	PAPER NUMBER
			2137	
			MAIL DATE	DELIVERY MODE
			10/25/2007	PAPER

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**BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES**

Application Number: 09/732,333  
Filing Date: December 06, 2000  
Appellant(s): PIRKEY ET AL.

**MAILED**

**OCT 25 2007**

**Technology Center 2100**

Mark J. Danielson  
Reg. No. 40,580)  
For Appellant

**EXAMINER'S ANSWER**

This is in response to the appeal brief filed 08/14/2007  
appealing from the Office action mailed 12/21/2006.

**(1) Real Party in Interest**

A statement identifying by name the real party in interest is contained in the brief.

**(2) Related Appeals and Interferences**

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

**(3) Status of Claims**

The statement of the status of claims contained in the brief is correct.

**(4) Status of Amendments After Final**

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

**(5) Summary of Claimed Subject Matter**

The summary of claimed subject matter contained in the brief is correct.

**(6) Grounds of Rejection to be Reviewed on Appeal**

The appellant's statement of the grounds of rejection to be reviewed on appeal is correct.

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**(7) Claims Appendix**

The copy of the appealed claims contained in the Appendix to the brief is correct.

**(8) Evidence Relied Upon**

6330311	MIJARES et al.	12-2001
6134447	HAVINIS et al.	10-2000
5737701	ROSENTHAL et al.	04-1998
5420910	RUDOKAS et al.	05-1995
WO 97/04602	ROWELL et al.	02-1997

**(9) Grounds of Rejection**

The following ground(s) of rejection are applicable to the appealed claims:

***Claim Rejections - 35 USC § 103***

Claims 1-2, 4, 6, 9, 11, 13, 16-17, 19, 21, 24, 26, and 28 are rejected under 35 U.S.C. 103(a) as being unpatentable over Havinis et al. (US 6134447) in view of Rosenthal et al. (US 5737701).

Referring to claims 1, 9, 16 and 24, Havinis et al. discloses concurrently maintaining a system-wide list associated with a plurality of subscribers and a separate and distinct plurality of lists associated with the subscribers; receiving a request for a resource (see column 4 lines 19-52, column 5 line 45 through column 6 line 55); first checking the system wide

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list; if the resource is included in the system wide list providing or denying access to the resource in accordance with the system wide list and if the resource is no on the system wide list retrieving and comparing the subscriber list and allowing access if he resource is included in the list associated with the subscriber (see figure 4 and correspond description in columns 5 and 6).

Havinis et al. fails to disclose the requirement of inputting a PIN if the subscriber is not on the list.

However, Rosenthal et al. teaches requiring the subscriber to input a personal identification number if the resource is not included in the list associated with the subscriber and providing access to the resource if the subscriber inputs the correct personal identification number (see column 5 lines 35-67, column 6 lines 1-38, 63-67, column 7 lines 1-9).

At the time of the invention it would have been obvious to a person of ordinary skill in the art to require the use of a PIN in the Havinis et al. system.

Motivation to do so would have been help prevent fraud in the system (see Rosenthal column 2 line 60 through column 3 line 2).

As per claims 2 and 17, the modified Havinis et al. and Rosenthal et al. system discloses the claimed limitation wherein

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comprising the step of adding the resource to the list associated with the subscriber if the subscriber inputs the correct personal identification number (see Rosenthal et al Column 7, lines 10-22).

As per claims 4, 11, 19 and 26, the modified Havinis et al. and Rosenthal et al. system discloses an always deny list (see Havinis et al. column 4 lines 41-52).

As per claims 6, 13, 21, and 28, the modified Havinis et al. and Rosenthal et al. system discloses the claimed limitation wherein the resource is a telephone connection to a destination phone number (see Rosenthal et al Column 6, lines 5-9).

Claims 5, 12, 20, 27, 33, 36, 39, and 42 are rejected under 35 U.S.C. 103(a) as being unpatentable over the modified Havinis et al. and Rosenthal et al. system as applied to claims 1, 9, 16, and 24 above, and further in view of Mijares Jr. et al (US 6330311).

As per claims 5, 12, 20, 27, 33, 36, 39, and 42, the modified Havinis et al. and Rosenthal et al. system fails to disclose an always require PIN list for numbers associated with 900 or international calls.

However Mijares Jr. et al teaches such a list (see column 9 lines 10-43).

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At the time of the invention it would have been obvious to a person of ordinary skill in the art to use Mijares Jr. et al.'s always require PIN list for 900 or international calls in the call restricting method of the modified Havinis et al. and Rosenthal et al. system.

Motivation to do so would have been to allow a user to call the blocked 900 or international numbers (see Mijares Jr. et al column 9 lines 37-43).

Claims 31, 34, 37, and 40 are rejected under 35 U.S.C. 103(a) as being unpatentable over the modified Havinis et al. and Rosenthal et al. system as applied to claims 1, 9, 16 and 24 above, and further in view of Rowell et al (WO 9704602).

As per claims 31, 34, 37, and 40, the modified Havinis et al. and Rosenthal et al. system fails to disclose the always allow list comprises a phone number associated with emergency services

However Rowell teaches such a list (see Rowell page 3 lines 3-11).

At the time of the invention it would have been obvious to a person of ordinary skill in the art to include emergency numbers on the always allow list of the modified Havinis et al. and Rosenthal et al. system.

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Motivation to do so would have been to always let emergency numbers be called (see page 3 lines 3-11).

Claims 32, 35, 38, and 41 are rejected under 35 U.S.C. 103(a) as being unpatentable over the modified Havinis et al. and Rosenthal et al. system as applied to claims 4, 11, 19, and 26 above, and further in view of Rudokas et al (US 5420910).

As per claims 32, 35, 38 and 41, the modified Havinis et al. and Rosenthal et al. system fails to disclose the always deny list comprises a phone number associated with fraudulent use.

However, Rudokas et al teaches such a list of fraudulent numbers (see column 5 line 59 through column 6 line 14).

At the time of the invention it would have been obvious to a person of ordinary skill in the art to use Rudokas et al's method of preventing fraudulent numbers from being called in the call restricting service of the modified Havinis et al. and Rosenthal et al. system.

Motivation to do so would have been prevent cloned identification systems from making calls to fraudulent numbers (see Rudokas et al column 5 line 59 through column 6 line 14).



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**(10) Response to Argument**

Appellant argues that neither Havinis nor Rosenthal teach or suggest two different lists of resources.

With respect to this argument Havinis teaches a black list which is a system wide list. The black list "can be used by the wireless service provider to temporarily bar the use of the location service by LAs" (see column 4 lines 61-63). The Locations Applications (LAs) are applications providing a location service to subscribers (see column 2 lines 9-34 where the subscriber requests the location service from the LA) and can be "associated with a group of subscribers" (see column 4 lines 19-36). When a LA is on the black list, all the subscribers (i.e. mobile stations) using this LA in the system are blocked from using the location application service. Therefore, the black list is a system wide list and it does not relate to individual subscribers but rather individual LAs, which are used by multiple users. After checking if the LA is on the black list the system checks to see if the mobile station (i.e. individual subscriber) is registered in the Home Location Register (HLR) see Figure 4 numeral 430 and column 6 lines 5-15). This step is the checking of a second list associated with the specific subscriber if not on a first system wide list (i.e.

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the black list). The black list of Havinis contains a list of blocked LAs which are resources used by the subscribers. Therefore, Havinis teaches a system wide list of resources associated with a plurality of subscribers regardless of subscriber identity. Havinis further teaches checking a second list associated with a specific subscriber (i.e. checking the HLR); and when combined with Rosenthal, the combined references teach checking a second list of resources associated with a subscriber. Therefore, the combination of Havinis and Rosenthal teach two different lists of resources.

Appellant argues Havinis' black list is not a system wide list of resources because LAs are subscribers.

With respect to this argument, as stated above, the LAs have a group of mobile stations (i.e. subscribers to the LA) associated with each LA to perform location applications such as a "Where am I service" requested by the mobile station (see column 2 lines 9-34). These LAs can be on the black list and therefore blocked system wide and therefore blocking any mobile station from using the LA service regardless of the mobile station's identity. Additionally, the second list is verifying that the specific mobile station is registered in the HLR. Therefore,

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Havinis teaches checking a system wide list and checking a subscriber specific list. Furthermore, Appellant argues that Havinis associates one group of subscribers (i.e. multiple cell phones) with another subscriber (i.e. one LA) and can block specific LAs (see page 12). In response to this remark, the multiple cell phones (i.e. the first group of subscribers) can be blocked without specifically identifying any of these cell phones individually because they are blocked based on the associated LA. Therefore the LA identifier number (LAIN) works as a group ID for the multiple cell phones blocking specific LAs and therefore specific subscribers (i.e. the cell phones) throughout the system (i.e. system-wide) regardless of the subscriber's (i.e. cell phone) identity.

Appellant argues that Havinis and Rosenthal combined do not suggest the claimed lists of resources.

With respect to this argument, the LAs are resources available to the mobile stations (i.e. subscribers). Therefore, as explained above, the black list of Havinis is a system wide list of resources blocked by the system. Additionally, the Rosenthal system teaches a subscribers list of destination phone numbers (i.e. a list of resources associated with the subscriber).

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Therefore, the combination of Havinis and Rosenthal suggest the claimed lists of resources.

Appellant argues that the prior art fails to support a prima facie case of obviousness.

Appellant specifically states that Havinis is related to preventing fraud and therefore the motivation provided in Rosenthal as, "to help prevent fraud in the system" (see column 2 line 60 through column 3 line 2) is improper. However, nowhere in Havinis is it stated that the black and grey lists are used to prevent fraud. The lists are used to "ensure that the LAs 380 requesting positioning have paid for the location service" (see column 5 lines 15-17). Therefore, the provided motivation from Rosenthal is proper. Applicant additionally admits (see page 14) that it would be at least obvious to try, to which the Examiner agrees. The Appellant also argues that impermissible hindsight has been used, however, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only

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from the applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971). In this case the prior art provides motivation to combine the references and therefore the rejections are proper.

Appellant argues that if the references were combined the principle operation would be changed.

With respect to this argument, as explained above, the black system wide list of Havinis would remain the same, but the second list that checks whether the mobile station is registered in the HLR would be modified to be a list of resources associated with the subscriber as taught by Rosenthal. Therefore, the principle operation of either of the references would not change because they each would still allow or block a subscriber access based on lists.

**(11) Related Proceeding(s) Appendix**

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

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For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

Michael J. Pyzocha

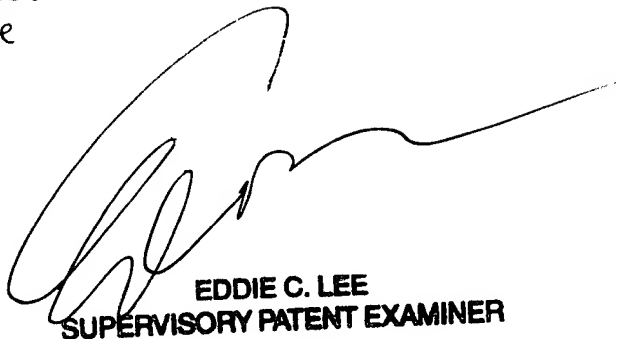


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